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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,682	04/04/2001	Elena Feinstein	65503-B/JPW/MS	3555

7590 02/25/2003
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EXAMINER

JOHANSEN, DIANA B

ART UNIT PAPER NUMBER

1634

DATE MAILED: 02/25/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,682

Applicant(s)

FEINSTEIN ET AL.

Examiner

Diana B. Johannsen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,2,4-7, and 9-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restriction

1. Applicant's election with traverse of Group I and of SEQ ID Nos 56 and 57 in Paper No. 16 is acknowledged. In paper no. 16, Applicant canceled claims 3 and 8, amended claims 1-2, 4, 7, 9 and 24, and added claims 26-29. Claims 1-2, 4-7, and 9-29 are now pending. In view of applicant's amendments, a further election is required, as set forth below.
2. Elected Group I now includes claims 1-2, 4-7, 9, 24, and 26-29. Applicant has amended the claims of this group such that all the claims now require determining the level of expression of "at least two polypeptide-encoding polynucleotides" (see independent claims 1, 7, and 9), and has added claims that require determining the level of expression of "at least three polypeptide-encoding polynucleotides" (see new claims 26 and 27). Further, applicant has amended all of the claims to recite particular SEQ ID Nos from which polynucleotide sequences are to be selected. Accordingly, in view of applicant's amendments, applicant must elect an additional SEQ ID NO from those recited in the claims. **Examination of the claims will be restricted to the previously elected combination of SEQ ID NO: 56 and SEQ ID NO: 57, and to the combination of SEQ ID NO: 56, SEQ ID NO: 57, and the third SEQ ID NO elected in response to this requirement. This is not an election of species.**
3. As was discussed in the Election/Restriction of paper no. 13, MPEP 803.04 states:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is

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presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 *et seq.*

The multiple combinations of sequences encompassed by the claims of the elected Group are patentably distinct by virtue of having different structures and encoding or depicting different combinations of proteins. These different combinations of molecules are deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. A reference against one combination would not be a reference against another, and, in view of this and the multitude of sequences submitted for examination by the USPTO, a search of SEQ ID NOS encoding or depicting more than one distinct combination of proteins would pose a serious burden. It is noted that as the claims now specifically recite combinations of "at least three" polynucleotides, Applicant may elect, as set forth above, one combination of three polynucleotides that includes the previously elected combination of SEQ ID NO: 56 and SEQ NO: 57.

4. It is noted that a response to the traversal of paper no. 16 and of any traversal submitted in response to the instant requirement will be provided in the first Office action on the merits.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 703/305-0761. The examiner can normally be reached on Monday-Friday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached at 703/308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0196.

A handwritten signature in dark ink, appearing to read "Diana B. Johannsen", followed by a long, horizontal, slightly wavy line that extends to the right.

Diana B. Johannsen
February 21, 2003